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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/058,496	04/10/1998	JEFFREY H. MICHAUD	07844/273001	7535

7590 10/24/2002

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REDWOOD CITY, CA 94063

EXAMINER

BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 10/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/058,496

Applicant(s)

MICHAUD ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 13, 15, 16, 20-22, 24, 25 and 28-44 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 1-9, 12, 13, 15, 16, 20-22, 24, 25, 28-36 and 38-43 is/are rejected.

- 7) ☒ Claim(s) 37 and 44 is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: amendment filed 7/31/2002 to the original application filed 4/10/1998. IDS filed 7/19/1999, and 11/30/2000. No priority or provisional filing date is claimed.
2. Claims 37, 44 remain objected to by the examiner.
3. Claims 1-5, 7-9, 12-13, 20-22, 29-30, 35-36, 42-43 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit and White.
4. Claims 15-16, 24-25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit, White, and Nielsen.
5. Claims 6, 28, 31-34, 38-41 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit, White, and Habermehl.
6. Claims 1-9, 12-13, 15-16, 20-22, 24-25, 28-44 are pending. Claims 1 and 5 are independent claims.

Allowable Subject Matter

7. **Claims 37, 44 are objected to** as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5, 7-9, 12-13, 20-22, 29-30, 35-36, 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit Imagemap Editing Software (hereinafter Mapedit), Version 2.3 for Windows 3.1, 1997 by Boutell.Com, Inc. URL: <http://www.boutell.com/mapedit>, pp.1-19, in view of White et al. (hereinafter White), U.S. Patent No. 6,034,689 issued March 2000.

In regard to independent claim 1, Mapedit teaches:

- image mapping of a selected file (Mapedit Figure 9 paragraph 1,2). Mapedit does not specifically teach inputting a graphic file containing layers. However, Mapedit teaches the saving of edited overlapping layered image regions (Mapedit Figures 17-19; compare with claim 1 "*a layer in an electronic artwork having a plurality of layers*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to input said image mapped graphic, because of Mapedit's taught advantage of reopening and editing such files.

- user selection of a layer, as well as an image containing non-transparent, as well as transparent layers within an image (Mapedit Figures 17, 18; compare with claim 1 "*receiving from a user an input selecting....of one or more non-transparent regions in a transparent frame*").

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- portioned areas of a graphic file, with a specific URL assigned to each portion so as to activate a URL when an area is selected. Mapedit also teaches a non-transparent region defining a hot spot region (Mapedit Figures 4, 5, 10, 17, 18; compare with claim 1 *"in response to the input selecting a layer....a perimeter boundary of the one or more non-transparent regions in the selected layer;"* and *"assigning an action to the area, the action defining a function that is to be activated when the area is selected."*).

- Mapedit does not specifically teach defining an area by automatically determining a perimeter boundary. However, White teaches automatic rescaling of an image map area subsequent to resizing of a Web page to fit different display areas (White column 15 lines 24-37; compare with claim 1 *"defining an area by automatically determining a perimeter boundary"*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the method of White to the method of Mapedit, because of White's taught advantage of scaling, providing a way for Mapedit to create imagemaps for different presentation mediums by automatically determining image map boundaries subsequent to changes in size of an imagemap.

- an image map, whereby a selected region (area) is selected, resulting in an action mapped from said region corresponding to a portion of an image (Mapedit Figure 17; compare with claim 1 *"associating the area and the action with the selected layer as a property of the selected layer in the electronic artwork"*).

In regard to dependent claim 2, Mapedit teaches a method of assigning a URL to a selected region (Mapedit Figure 5; compare with claim 2).

In regard to dependent claim 3, Mapedit teaches compositing of images (Mapedit Figure 17; compare with claim 3 *"compositing the layers of the artwork"*).

In addition, Mapedit teaches a method of converting a hotspot area along with associated URLs to an HTML file format (Mapedit Figure 16; compare with claim 3 “*converting the area and the action to a target output format.*”).

In regard to dependent claim 4, Mapedit teaches a method of converting a hotspot area along with associated URLs to an HTML file format (Mapedit Figure 16; compare with claim 4).

In regard to independent claim 5, Mapedit teaches:

- image mapping of a selected file (Mapedit Figure 9 paragraph 1,2). Mapedit does not specifically teach inputting a graphic file containing layers. However, Mapedit teaches the saving of edited overlapping layered image regions, with defined hotspot regions (Mapedit Figures 17-19; compare with claim 5 “*receive an electronic artwork having a plurality of layers, each layer having transparency information defining one or more non-transparent regions in the layer in a transparent frame*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to input said image mapped graphic, because of Mapedit’s taught advantage of reopening and editing such files.

- user selection of a layer (Mapedit Figures 17, 18; compare with claim 5 “*receive from a user an input selecting one of the plurality of layers*”).

- portioned areas of a graphic file, with a specific URL assigned to each portion so as to activate a URL when an area is selected, said area defined by a boundary. Mapedit also teaches an image map, whereby a selected region (area) is selected, resulting in an action mapped from said region corresponding to a portion of an image (Mapedit Figures 4, 5, 10, 17; compare with claim 5 “*in response to the input selecting a layer....in the selected layer*” and “*assign an action to an area defining a function that will be activated when the area is selected*”).

- Mapedit does not specifically teach defining an area by automatically determining a perimeter boundary. However, White teaches automatic rescaling of an image map area subsequent to resizing of a

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Web page to fit different display areas (White column 15 lines 24-37; compare with claim 5 “*define an area by automatically determining a perimeter boundary*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the method of White to the method of Mapedit, because of White’s taught advantage of scaling, providing a way for Mapedit to create imagemaps for different presentation mediums by automatically determining image map boundaries subsequent to changes in size of an imagemap.

In regard to dependent claims 7 and 8, claims 7 and 8 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 3 and 4, respectively, and are rejected along the same rationale.

In regard to dependent claim 9, Mapedit teaches a method whereby a mapped image is presented (Mapedit Figure 17). Mapedit does not specifically teach the saving of a composited image as an image file. However, since Mapedit teaches the presentation and saving of an image with different mapped layers, with both said image and said layers reproducible within the Mapedit editor environment, it would have been obvious to one of ordinary skill in the art at the time of the invention to save said layers as an image file, because of Mapedit’s taught advantage of the presentation and saving of layers with images.

In addition, Mapedit teaches a method of saving an HTML file including an associated graphics file and a hotspot with associated URLs (Mapedit Figures 2, 16; compare with claim 9 lines 4-6).

In regard to dependent claim 12, Mapedit teaches a method whereby areas of edited graphic file are portioned with a specific URL assigned to each bounded portion so as to activate a URL when an area is selected, said area of bounded portion displayed in reverse color when activated (Mapedit Figures 4, 5, 10). Mapedit does not specifically teach a method of conforming the area automatically to content of

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the selected layer subsequent to editing of said layer. However, White teaches the rescaling of an image map area subsequent to the resizing of a web page to fit different display areas (White column 15 lines 24-37; compare with claim 12 "*conforming the area automatically to content of the selected layer*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the method of White to the method of Mapedit, because of White's taught advantage of scaling, providing a way for preserving an image map subsequent to changes in size of the the edited imagemap method as taught by Mapedit.

In regard to dependent claim 13, Mapedit teaches the calculation of dynamic content for a selected layer before the area is calculated, since it is known in the art that currently edited information is considered dynamic information until saved, Mapedit's calculation and formulation of hotspots is based upon dynamic content, prior to saving.

In regard to dependent claims 20, 21, 22, claims 20, 21, 22 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 11, 12, 13, respectively, and are rejected along the same rationale.

In regard to dependent claim 29, Mapedit teaches an artwork graphic as an image file, as well as an HTML file with image map and URL (Mapedit Figure 2; compare with claim 29).

In regard to dependent claim 30, Mapedit teaches an action as a URL (Mapedit Figure 5; compare with claim 30).

In regard to dependent claim 35, Mapedit teaches determination of a perimeter of a non-transparent region, the area of which is assigned a hyperlink (Mapedit page 5; compare with claim 35).

In regard to dependent claim 36, Mapedit teaches creation of circular region 1, said region remaining unassigned to a hyperlink, with another circular region 2 created and defined as a superset of region 1, with said region 2 assigned an address of the USPTO home page (Mapedit pages 20-21). As the imagemap becomes active, the unassigned circular region 1 becomes a "hole" (an unassigned region) within the perimeter of the USPTO circular region 2 (Mapedit pages 22-23), yet is still part of the area of the overall circular region 2.

In regard to dependent claims 42, 43, claims 42, 43 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 35, 36 respectively, and are rejected along the same rationale.

10. **Claims 15-16, 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit and White as applied to claims 1 and 5 above, and further in view of Nielsen, U.S. Patent No. 5,991,781 issued November 1999.**

In regard to dependent claim 15, claim 15 incorporates substantially significant subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Mapedit teaches multiple hot spot regions within an image (Mapedit Figure 5; compare with claim 15 "*the selected layer has two or more non-contiguous*", and "*...in a transparent frame*"). Mapedit does not specifically teach the inclusion of two or more non-transparent regions. However, Nielsen teaches at least two non-transparent regions (Nielsen Figures 1b, 11; compare with claim 15 "*...non-transparent...*"). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the method of Nielsen to the method of Mapedit, because of Nielsen's taught advantage of non-transparent images, providing an alternate way to show regions within an image.

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In addition, Mapedit teaches multiple hot spot regions within an image, said regions can encompass the entire image (Mapedit Figure 5; compare with claim 15 "*the area defined....regions in combination*").

In regard to dependent claim 16, claim 16 incorporates substantially significant subject matter as claimed in claim 15, and in further view of the following, is rejected along the same rationale.

Mapedit teaches a method whereby multiple image maps can be defined in different areas of an image (Mapedit Figure 4; compare with claim 16 line 2, "*generating multiple image maps*").

In regard to dependent claims 24-25, claims 24-25 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 15-16, respectively, and are rejected along the same rationale.

11. Claims 6, 28, 31-34, 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mapedit and White as applied to claim 1 above, and further in view of Habermehl, U.S. Patent No. 5,956,701 issued September 1999.

In regard to dependent claim 6, Mapedit teaches a method of creating a polygon-shaped area on a graphics file by creating boundaries via a mouse, said boundaries created until an enclosed polygon is created, said area within said enclosed polygon reverses color when subsequently activated via said mouse (Mapedit Figure 5, 10, 12). Mapedit does not specifically teach calculating hot spot areas by utilizing perimeter boundaries. However, Habermehl teaches defining hot spot areas taking into account the boundaries of an area, said defining accomplished via neural net (Habermehl column 3 lines 35-40, Figures 3, 6; compare with claim 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Habermehl to Mapedit, because of Habermehl's taught advantage of

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calculating areas, providing a way for defining portions of an image using fewer inputs and less redundancy to Mapedit (Habermehl column 2 lines 59-61).

In regard to dependent claim 28, claim 28 reflects the method comprising computer readable instructions used for implementing the computer program as claimed in claim 6, and are rejected along the same rationale.

In regard to dependent claims 31-34, Mapedit teaches user selection of a shape (ie. circle, rectangle, polygon) Mapedit page 8; compare with claims 31-34).

In regard to dependent claims 38-41, claims 38-41 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 31-34, respectively, and are rejected along the same rationale.

12. Prior art made of record and not relied upon is considered pertinent to disclosure.

Bates et al.	U.S. Patent No. 6,374,272	issued	04/2002
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Response to Arguments

13. Applicant's arguments filed 7/31/2002 have been fully and carefully considered but they are not persuasive.

Applicant argues on pages 7-8 (also page 9, at top) of the amendment that in Mapedit, a "layer" does not exist until a hotspot has been defined by a user, that is the original artwork does not include layers, as opposed to Applicant's assertion that a selected layer exists before an area is defined. The examiner notes that an "electronic artwork" can comprise any electronic image and/or text in possible combination with associated imagemaps and/or any other electronic object(s). Mapedit teaches saving

imagemaps, including associated hotspot and boundary references. An image with existing hotspot layers can be interpreted as an original artwork authored by a user. The original (imagemap) artwork can be inputted by a user for further editing, resizing, etc. Applicant asserts that a selected layer exists before the area is defined. However, the claims do not preclude selecting an existing layer, and resizing said layer. At the point of resizing (pending release of the mouse), the new hotspot area and boundary has not been finalized by the system. The system subsequently adjusts the area/boundaries accordingly, therefore creating a new area with a new boundary perimeter.

Applicant's argues on pages 8-9 of the amendment that the cited art does not teach defining an area by automatically determining a perimeter boundary of the one or more non-transparent regions in a selected layer. The examiner noted that White is used to teach automatically determining a perimeter boundary. Mapedit appears to require initial user intervention to create or resize a perimeter boundary. White teaches rescaling of X,Y coordinates of an imagemap page when it is determined that said page is scaled to fit another medium (i.e. television, etc.). The rescaling of said imagemap is automatically performed, and is dependent upon the dimensions of the final medium (i.e. television screen size). Since the area of a hotspot shape is determined by at least its hotspot boundary, rescaling said X, Y coordinates of an imagemap is indicative of automatically determining a new (resized) boundary perimeter. Mapedit teaches a non-transparent region (see White column 15 lines 22-28). The automatic rescaling and re-dimensioning of the imagemap is applied to Mapedit's editor to provide provisions for various alternate mediums.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Bashore whose telephone number is (703) 308-5807. The examiner can normally be reached on Monday through Friday from 11:30 AM to 8:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

16. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239 (for formal communications intended for entry)

or:

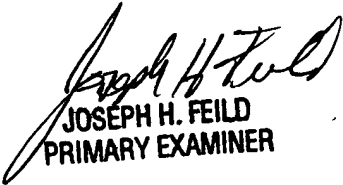
(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

or:

(703) 746-7238 (for after-final communications)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Fourth Floor (Receptionist).

William L. Bashore
10/19/2002


JOSEPH H. FEILD
PRIMARY EXAMINER